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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,355	09/13/2004	Erica Tsai	60154.301803	5354

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INTELLECTUAL PROPERTY LAW OFFICE
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EXAMINER

WALSH, DANIEL I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,355

Applicant(s)

TSAI ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Re Para 2, line 4: Replace "rotationally disk" with -- rotationally in a disk --.

Re Para 8, line 4: Replace "which." with -- which, --.

Re Para 8, line 5: Replace "Accordingly," with -- Accordingly, the --.

Further, the Examiner notes that the specification contains bolded and bracketed headings (such as Para 1) for each paragraph.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 8-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,561,420.

Although the conflicting claims are not identical, they are not patentably distinct from each other

because the present claimed invention is a broader recitation of the '420 patent, and the differences are well known and obvious in the art, and do not patentably distinguish the present claimed invention.

For instance in claim 1 of the present claimed invention and claim 1 of the '420 Patent, the Applicants claim:

i) "A system for distributing data... front surface...back surface...four edges...one stripe zone...ring zone...magnetically recorded instances of data...read mechanism." (see claim 1), whereas in the '420 Patent, the Applicants claim "A system for distributing data... front surface...back surface...four edges...one stripe zone...ring zone...magnetically recorded instances of data...read mechanisms." (see claim 1).

Though the current claimed invention differs from the '420 Patent in that it calls for a stationary read mechanism, the Examiner notes that such modification is well known and obvious in the art, (stationary readers) and that such modification does not patentably distinguish the present claimed invention.

For instance in claim 2 of the present claimed invention and claim 2 of the '420 Patent, the Applicants claim:

ii) "...contain the data...identifiers associated with at least some of the data...initiates an action automatically...data identifiers." (see claim 2), whereas in the '420 Patent, the Applicants claim "...contain the data...identifiers associated with at least some of the data...initiates an action automatically...data identifiers." (see claim 2).

For instance in claim 3 of the present claimed invention and claim 3 of the '420 Patent, the

Applicants claim:

iii) "...database of records...identified fields...when said data identifiers...match said uniquely identified fields." (see claim 3), whereas in the '420 Patent, the Applicants claim "...database of records...identified fields...when said data identifiers...match said uniquely identified fields." (see claim 3).

For instance in claim 4 of the present claimed invention and claim 4 of the '420 Patent, the

Applicants claim:

iv) "...telephone device...dialing said telephone number." (see claim 4), whereas in the '420 Patent, the Applicants claim "...telephone device...dialing said telephone number." (see claim 4).

For instance in claim 5 of the present claimed invention and claim 5 of the '420 Patent, the

Applicants claim:

v) "... (GPS) device...displaying a map or route based on the GPS data..." (see claim 5), whereas in the '420 Patent, the Applicants claim "... (GPS) device...displaying a map or route based on the GPS data..." (see claim 5).

Re claims 8 and 15, though the '420 Patent is silent to plastic or paper as a substrate material, the Examiner notes that it is well known and conventional that card are made of

plastic/paper. As such limitations are so well known and conventional, they do not distinguish the present claimed invention from the prior art of record.

For instance in claim 9 of the present claimed invention and claim 6 of the '420 Patent, the Applicants claim:

vi) "...front surface, a back surface...visually recognizable indicia...stripe zone...ring zone...read mechanism." (see claim 9), whereas in the '420 Patent, the Applicants claim "...front surface, a back surface...visually recognizable indicia...stripe zone...ring zone...read mechanism." (see claim 6).

Though the current claimed invention differs from the '420 Patent in that it calls for a stationary read mechanism, the Examiner notes that such modification is well known and obvious in the art, (stationary readers) and that such modification does not patentably distinguish the present claimed invention.

For instance in claim 10 of the present claimed invention and claim 7 of the '420 Patent, the Applicants claim:

vii) "...zones does contain the data." (see claim 10), whereas in the '420 Patent, the Applicants claim "...zones does contain the data."

For instance in claim 11 of the present claimed invention and claim 8 of the '420 Patent, the Applicants claim:

viii) "...data includes at least one encoded version of at least some of the visually recognizable indicia..." (see claim 11), whereas in the '420 Patent, the Applicants claim "...data includes at least one encoded version of at least some of the visually recognizable indicia..." (see claim 8)

For instance in claim 12 of the present claimed invention and claim 9 of the '420 Patent, the Applicants claim:

"...data identifiers associated with at least some of the data." (see claim 12), whereas in the '420 Patent, the Applicants claim "...data identifiers associated with at least some of the data." (see claim 9)

3. Claims 6 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,561,420 in view of U.S. Patent No. 5,942,744.

Though the '420 Patent is silent to a data orientator, the Examiner notes that such orientations are well known and conventional in barcodes, magnetic stripes, and ring zones. Such orientators can take the form of a recognizable string of data indicating an orientation, or can take the form of a physical mark detected to determine orientation. Specifically, the '744 Patent teaches (col 39, lines 58+) data orientators to permit a card to be inserted and read regardless of orientation. Accordingly, it would have been obvious to an Examiner of ordinary skill in the art to combine the teachings, in order to permit reading of a card regardless or orientation.

4. Claims 7 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,561,420 in view of U.S. 2003/0205615. Though the '420 Patent is silent to extensible markup language tagging, the '615 art teaches (abstract, for example) so that data can be processed easily with most available software. Therefore, it would have been obvious to an Examiner of ordinary skill in the art to combine the teachings to make the card more convenient for use.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Liu et al. (US 20040218518, 20040159707, and 20020186495), Tsai et al. (US 20030127521 and 6789738), King et al. (US 20040076105), Kamo et al. (US 6016959), Han et al. (US 6135355), Conner et al. (US 20030024995), and Jones (US 6068311).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
11/22/04



KARL D. FRECH
PRIMARY EXAMINER